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REMARKS

Claims 151-241 are currently pending in the application.

During a telephonic interview between the undersigned attorney and the examiner on January 26, 2006, it was agreed that the combination of features as defined in independent claim 151 is not anticipated by either Hoyle (US 6,141,010), Yoneda (US 6,785,740) or McBrearty (IS 6,848,077). Additionally it was agreed that the combination of features as defined in claim 151 below is not obvious in view of Hoyle in combination with Yoneda.

Claims 151-160, 163-170, 173-191, 193-204,207-215, 217-234 and 236-241 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,141,010 to Hoyle in view of U.S. Patent No. 6,785,740 to Yoneda et al. and U.S. Patent No. 6,848,077 to McBrearty et al. This rejection is respectfully traversed.

On page 4 of the office action, the examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the dynamic keyword markup functionality of Yoneda to Hoyle's system and method so as to mark up additional keywords in Hoyle's documents with links to Hoyle's corresponding banner ads, and that one would have been motivated to do so in order to provide the user with access [via the dynamically marked-up hyperlink] to as much additional information (i.e. other banner adds in Hoyle) he/she may be interested in as possible, without detracting from the original document or distracting the user. Applicant respectfully disagrees.

For example, MPEP Section 2143.01 states that the prior art must suggest the desirability of the claimed invention. Although the examiner states that Yoneda suggests such motivation, applicant respectfully asserts that there does not appear to be any teaching or suggestion in either Hoyle or Yoneda for the motivation as suggested by the examiner. Accordingly, applicant respectfully requests that the examiner cite to the specific text in Yoneda or Hoyle which teaches or suggests that it would be desirable to "provide the user with access [via the dynamically marked-up hyperlink] to as much additional information (i.e. other banner adds in Hoyle) he/she may be interested in as possible, without detracting from the original document or distracting the user."

Additionally, it is noted that the nature and general purpose of inserting banner advertisements (such as those as taught in Hoyle) is to distract the user so that the attention of the user is at least temporarily focused on the banner advertisement. Thus, because Hoyle teaches an

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advertising technique which is intended to detract from the original document and which is intended to distract the user, it is respectfully asserted that the examiner's suggested motivation for combining Hoyle and Yoneda is improper.

Additionally, Applicant's attorney wishes to seek further clarification from the examiner on this issue, by way of telephonic interview.

On page 16 of the office action, the examiner asserts that McBrearty is used solely to show common knowledge implementation details for ignoring non-searchable HTML elements in a text search process. However, in doing so, the examiner is choosing to ignore other teachings in McBrearty which teach away from the claimed invention.

The examiner is respectfully reminded that it is impermissible within the framework of Section 103 to pick and choose from a reference only so much of it as will support a conclusion of obviousness to the exclusion of other parts necessary to a full appreciation of what the reference fairly suggests to one skilled in the art. Moreover, MPEP Section 2141.03 requires the examiner to consider the prior art reference in its entirety (i.e., as a whole), including portions that would lead away from the claimed invention.

It is noted that one aspect of the present claimed invention is directed to a context-based advertising technique in which selected text from a web page (which is to be displayed on a client system) is identified, marked up, and linked to additional information relating to the advertiser's product. As a result, the web page which is displayed to the user on the client system may include additional hyperlinks which were generated using the context-based advertising technique of the present invention.

In contrast, McBrearty is directed to a technique for providing a user with a means for predetermining subject matter, terms and words for which the user desires to have hyperlinks in a received Web document. In this way, McBrearty provides a technique for allowing a user to display in the received Web document, multiple hyperlinks for each predetermined term of interest to thereby substantially reduce the user's browsing through several levels of Web documents in pursuit of topics of interest.

For example, McBrearty 1:45-2:5 states:

> *Web documents or pages have hyperlinks setting forth terms and topics which the user may interactively click on or select to access other Web documents which, in turn, respectively have their own hyperlinks selectable by the user to access the next Web documents. Thus, browsing*

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through Web documents often involves the time consuming process of following a thread of hyperlinked Web documents through several levels of hyperlinks, then backing up to a Web document at an earlier level, selecting another hyperlink in that document and then following another thread of hyperlinked documents through several levels.

Web developers and users are continually seeking implementations to make this Web document browsing process less cumbersome and more user friendly.

SUMMARY OF THE PRESENT INVENTION

The present invention addresses these user needs by providing the user and developer with an implementation providing the user with a means for predetermining subject matter, terms and words for which the user desires to have hyperlinks in a received Web document. It further provides for displaying in the received Web document, multiple hyperlinks for each predetermined term of interest to thereby substantially reduce the user's browsing through several levels of Web documents in pursuit of topics of interest.

From this teaching it is clear that one problem to be solved in McBrearty is the ability to make Web document browsing process less cumbersome and more user friendly. One solution proposed by the technique of McBrearty is to allow the user to restrict the display of hyperlinks of a retrieved webpage to subject matter, terms and words selected by the user. As a result, the technique of McBrearty teaches away from the technique of the present invention since, for example, McBrearty is directed to a technique for limiting or reducing displayed hyperlinks in a web document to those relating to subject matter, terms and words selected by the user, while at least one embodiment of the present claimed invention is directed to a technique for generating additional displayed hyperlinks in a web document relating to keywords or categories selected by an advertiser.

Further it is submitted that McBrearty teaches away from the teachings of both Hoyle and Yoneda. For example, both Hoyle and Yoneda are also directed to advertising techniques in which a portion of a document is analyzed using selected keyword information that has been provided by the advertiser. If it is determined that the document includes text relating to the selected keyword information, additional information (e.g., advertising related information) may

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be displayed to the user. However, McBrearty specifically <u>teaches away</u> from the techniques of both Hoyle and Yoneda by explicitly teaching that the <u>user</u> is provided with a means for predetermining subject matter, terms and words for which the user desires to have hyperlinks in a received Web document. (see e.g., McBrearty 1:62-67, 6:7-21)

Based at least upon this evidence, it is submitted that, when considered in its entirety as a whole, one having ordinary skill in the art would <u>not</u> be motivated to combine the teachings of McBrearty with that of Hoyle or Yoneda.

Moreover, even if one were to combine the teachings of McBrearty with that of Hoyle or Yoneda, the resulting device would realize the same features and/or benefits as defined, for example, in claim 151 (and/or other claims) of the present claimed invention. For example, because McBrearty is directed to a technique for limiting or reducing displayed hyperlinks in a web document to those relating to predefined words and terms of interest selected by the user, even if text in the web document were identified as being related to advertiser keyword information, the identified text would not be marked up as a hyperlink and displayed to the user unless such identified text also related to the predefined words and terms of interest selected by the user, as required by the explicit teaching of McBrearty.

Accordingly, it is believed that, when considered in its entirety as a whole, the combining of the teachings of McBrearty with that of Hoyle, Yoneda would result in a device which would not realize the same features and/or benefits as defined, for example, in claim 151 of the present claimed invention. Should the examiner disagree, Applicant's attorney wishes to seek further clarification from the examiner on this issue, by way of telephonic interview.

Independent claims 186, 195, 229, 237, 240 and 241 include language defining one or more features which are similar to those defined in claim 151. Accordingly, it is submitted that claims 186, 195, 229, 237, 240 and 241 are neither anticipated by or obvious in view of the cited prior art references, and are therefore believed to be allowable. Additionally, each of the presently pending dependent claims is also believed to be allowable since it depends upon a respective independent claim.

The additional limitations recited in the independent claims or the dependent claims are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from the cited prior art references, either separately or in combination thereof.
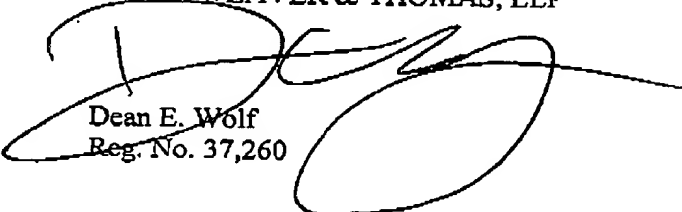
Because claims 151-241 are believed to be allowable in their present form, many of the examiner's rejections in the Office Action have not been addressed in this response. However,

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applicant respectfully reserves the right to respond to one or more of the examiner's rejections in subsequent amendments should conditions arise warranting such responses.

Applicants believe that all pending claims are allowable. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,
BEYER WEAVER & THOMAS, LLP

Dean E. Wolf
Reg. No. 37,260

P.O. Box 70250
Oakland, CA 94612-0250
(510) 663-1100

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